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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/472,490	12/23/1999	RYU TCHAO	102-302RE/CO	8828
23869	7590	06/14/2006		EXAMINER
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SYOSSET, NY 11791			ART UNIT	PAPER NUMBER
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/472,490

Filing Date: December 23, 1999

Appellant(s): TCHAO, RUY

Salvatore Abbruzzese
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 19, 2005 appealing from the Office action mailed December 22, 2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 46-50 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 and 38-41 of copending Application No. 09/966831. Although the conflicting claims are not identical, they are not patentably distinct from each other because the use of a non-destructive assay on either cells or organisms is merely a matter of choice.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

In view of the fact that additional errors in the original patent have been corrected through amendments to the claims, a new/supplemental oath or declaration complying with 37 CFR 1.63 and 1.175 is required.

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 46-50 are rejected as being based upon a defective declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

Claim 49 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 46-48 and 50 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for non-destructive chemotaxis assays, does not reasonably provide enablement for any and all types of non-destructive assays. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Appellant does not teach any and all types of non-destructive assays. Only non-destructive chemotaxis assays are contemplated. Appellant does not consider other non-destructive assays such as stereotaxis, phototaxis, electrotaxis, or geotaxis assays.

To make and use the invention with non-destructive assays, other than chemotaxis, would involve extensive experimentation.

Nowhere in the specification does Appellant contemplate any assay other than a chemotaxis assay. Appellant states on column 2, lines 32-36, that "I have developed a chemotaxis assay procedure ...", where the entire specification is specifically directed to a chemotaxis assay. Appellant does not consider other non-destructive assays such as stereotaxis, phototaxis, electrotaxis, or geotaxis assays. The assays are entirely different and the use of other assays would require extensive experimentation.

Claims 46-48 and 50 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for chemical agents, does not reasonably provide enablement for any and all types of agents. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Appellant does not teach any and all types of agents. Only chemical agents are contemplated. To make and use the invention with an agent other than a chemical agent would involve extensive experimentation.

Claims 46-48 and 50 are rejected under 35 U.S.C. 251 as being improperly broadened in a reissue application.

The claims have been broadened, as Appellant does not teach any and all types of non-destructive assays or any and all types of inducing agents.

(10) Response to Argument

Appellant has agreed that upon resolution of the claims on appeal, a terminal disclaimer will be filed.

Appellant has agreed that upon resolution of the claims on appeal, a suitable new/supplemental Oath or Declaration will be provided.

Appellant argues that the recited steps of the claimed cell migration assay procedure are sufficiently described to enable one skilled in the art to practice the claimed cell migration assay procedure and that the use of a chemo-attractant is merely the preferred method of causing cell migration.

As stated above, nowhere in the specification does Appellant contemplate any assay other than a chemotaxis assay. Appellant states on column 2, lines 32-36, that "I have developed a chemotaxis assay procedure ...", where the entire specification is specifically directed to a chemotaxis assay. Appellant does not consider other non-destructive assays such as stereotaxis, phototaxis, electrotaxis, or geotaxis assays. The assays are entirely different and the use of other assays would require extensive experimentation. There is absolutely no recognition in the specification of other types of assays other than chemotaxis.

Appellant does not teach any and all types of agents. Only chemical agents are contemplated. To make and use the invention with an agent other than a chemical

agent would involve extensive experimentation. Nowhere in the specification does Appellant contemplate anything other than a chemical agent.

Appellant is directed to the Specification. Under Field of the Invention, Appellant recites "(t)his invention relates to a chemotaxis assay procedure..." (see column 1, line 5). Under Background of the Invention, Appellant recites "(c)hemotaxis is broadly defined as the orientation or movement of an organism or cell in relation to a chemical agent," and further discusses chemotaxis procedures of the prior art (see specifically column 1, lines 14-15 and the entire Background). Under Summary of the Invention, Appellant recites "I have developed a chemotaxis assay procedure ..." and further lists steps, which only include a chemical agent (see specifically column 2, lines 32-36 and column 2, lines 40-64). Under Detailed Description of the Embodiments, Appellant only refers to "the chemotaxis procedure of this invention" and all of the Examples are directed to only a chemotaxis assay (see column 3, lines 32-35 and the Examples).

The claims have been broadened, as Appellant does not teach any and all types of non-destructive assays or any and all types of inducing agents.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

All of Appellant's arguments have been considered. None of them are seen to overcome the rejections advanced under 35 U.S.C. 112 and 35 U.S.C. 251.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Leslie Wong
619106

Leslie Wong
Primary Examiner
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Conferees:

APPEAL CONFEREES: *Robert J. Warden, Jr.*

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